

REMARKS

Claims 1-8, 11 and 12 stand rejected under 35 U.S.C. § 112, first paragraph (written description). This rejection is respectfully traversed for the following reasons. The Examiner alleges that the “original specification does not describe any selecting step, so references to a selection step are new matter” (*see* Remarks section on page 3 of the outstanding Office Action). The Examiner is apparently making this allegation because he could not find the specific word “select” in Applicants’ specification.

However, as is well known, “[b]y disclosing in a patent application a device that *inherently performs a function* ..., a patent application necessarily discloses that function ..., even though it says nothing explicit concerning it” (emphasis added)(*see* MPEP § 2163.07(a)). In the instant case, it is respectfully submitted that Applicants’ specification inherently discloses a selecting process notwithstanding the lack of an explicit reference to the term “select.”

For example, page 4, lines 17-20 of Applicants’ specification states that “the computer 2 receives the specific information of the firmware stored in the EEPROM 32 to 36, and compares the specific information [and] as a result of the comparison, the firmware of the latest version of the same type is stored in the RAM 3 through the disk interface controller 21.” This storage can be effected in which “the computer 2 commands transmission of the firmware to the disk device 22 which has the latest version ... [to] the RAM 3” (*see* page 6, lines 15-17 of Applicants’ specification).

It follows that the computer’s command for the disk device having the latest firmware to transmit its firmware to the RAM 3 is inherently a selection. That is, the

computer 2 selects the latest firmware *from among the plural disk devices* for transmission to the RAM 3 based on the disclosed comparison. Indeed, the term “select” broadly means “chosen from a number or group by fitness or preference” as defined by Merriam-Webster dictionary. Accordingly, for example, the latest version of firmware (i.e., fitness or preference) from the group of disk devices must first be chosen before it can be transmitted to the RAM 3.

As this is the sole rejection against claims 1-8, 11 and 12, it appears that the Examiner has agreed with Applicants’ previously filed arguments filed July 19, 2005 with respect to the distinction of these claims from the cited prior art. Otherwise, as expressly required pursuant to MPEP § 2163.06(I) under the heading Treatment of New Matter, “[t]he examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant.” Accordingly, because the Examiner did not set forth a prior art rejection against claims 1-8, 11 and 12, it appears that these claims are considered patentable over the cited prior art.

Moreover, as previously noted in the response filed July 19, 2005, the amendment introducing the term “select” was not relied upon for differentiating the present invention over the cited prior art, and was instead merely a rephrasing of the claims to improve grammatical syntax. Indeed, the arguments presented for differentiating the claims and Machida were directed to a feature of the present invention in which an update program starts running *in response to turning on a power source of the disk system*; in response to which the Examiner withdrew the prior art rejection over Machida independently of the reference to the term “select.” Accordingly, it appears that the introduction of the term

“select” had nothing to do with the Examiner’s withdrawal of the prior art rejection based on Machida.

Based on the foregoing, it is respectfully requested that the rejection under 35 U.S.C. § 112, first paragraph be withdrawn.

Claims 14 and 15 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Machida. This rejection is respectfully traversed for the following reasons. The Examiner maintains the pending rejection by asserting that, in Machida, “[w]hen update is made to the firmware of the multiple disks, the update *can* be made to each of the disks having firmware in need of updating” (emphasis added). The Examiner concludes by asserting that “Machida does not suggest any exclusion to the system in which only one single disk can ever be updated [whereby in the device of Machida] all of the disks having a firmware version *can* be updated ...” (emphasis added). The Examiner’s assertions, however, are not relevant to the standards required to make a rejection under § 102.

Specifically, 35 U.S.C. § 102 requires that each and every element of the claim be disclosed, either expressly or inherently (noting that “inherency may not be established by probabilities or possibilities”, *Scaltech Inc. v. Retec/Tetra*, 178 F.3d 1378 (Fed. Cir. 1999)). Accordingly, even assuming *arguendo* that Machida can perform updates to all of the disk devices as alleged by the Examiner, such a conclusion is NOT sufficient to read on the limitation recited in claim 14 (similarly in claim 15) that “the “computer ... updates the firmware of *each* of said plurality of disk devices to said latest version” (emphasis added).

Indeed, Machida expressly discloses updating the firmware of only the *replacement disk device* so as to teach away from updating the firmware of *each* of the plurality of disk devices to the latest version. In this regard, if the replacement disk device of Machida itself has the latest version of firmware, NO updating takes place which has the drawback of having disk devices without the latest version firmware (see col. 10, lines 14-26 of Machida); whereas in the present invention, the firmware of the “new disk device” would be used to update the other lower version “reference” disk device(s) to the latest firmware. Machida simply is not concerned with maintaining the firmware of each of the existing disk devices in the system at the latest version, but is limited in scope to the situation when a replacement device is added and is therefore completely unrelated to the objectives of the present invention and silent as to how to obtain the claimed function/operation.

Machida is completely silent as to suggesting updating all disk devices to the latest version; and the allegation that Machida “can” do so is irrelevant to establishing anticipation under § 102, which requires that Machida *in fact* expressly or inherently teaches updating *all* of the disk devices. Indeed, according to the Examiner’s standard for § 102 anticipation, prior art which discloses only a computer *generally* would anticipate all patent claims which recite a computer performing *specific* functions/operations even if the prior art computer is not programmed to do so, which is clearly improper. In the instant case, the system of Machida is not configured to update the firmware of *each* of said plurality of disk devices to said latest version, and its alleged capability to do so is not relevant for § 102 purposes.

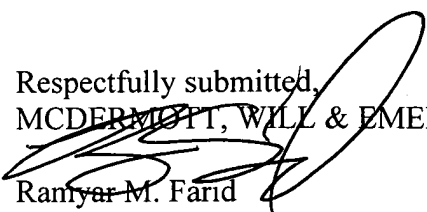
In this regard, the capability to obtain the claimed invention is not even sufficient for the less stringent standards of establishing obviousness under § 103 as set forth in MPEP § 2143.01 under the subsection entitled "Fact that the Claimed Invention is Within the Capabilities of One of Ordinary Skill in the Art is Not Sufficient by Itself to Establish *Prima Facie* Obviousness."

Based on the foregoing, it is respectfully requested that the rejection under 35 U.S.C. § 102 be withdrawn.

CONCLUSION

Having fully responded to all matters raised in the Office Action, Applicant submits that all claims are in condition for allowance, an indication for which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, the Examiner is requested to call Applicant's attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,
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